

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 11-24 are presently pending in this case. Claims 19 and 20 are amended by the present amendment. As amended Claims 19 and 20 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Official Action, the specification was objected to; the specification was objected to; Claims 18 and 20 were rejected under 35 U.S.C. §103(a) as unpatentable over Misawa (Japanese Patent Application Publication No. 2002-208900) in view of Tsubokura (Japanese Patent Application Publication No. 2000-341593); Claims 11-14, 17, 19, and 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Misawa in view of Tsubokura and further in view of Nakamura (Japanese Patent Application Publication No. 2002-344842); and Claims 15, 16, and 22 were rejected under 35 U.S.C. §103(a) as unpatentable over Ikuo et al. (Japanese Patent Application Publication No. 2002-342351, hereinafter “Ikuo”) in view of Misawa and further in view of Tsubokura.

With regard to the objection to the specification, Claims 19 and 20 are amended to recite “a non-transitory computer readable medium.” This amendment is made pursuant to the statement dated January 26, 2010 by U.S.P.T.O. Director Kappos in which U.S.P.T.O. Director Kappos states that the U.S.P.T.O. will interpret the term “non-transitory” to exclude signals, and thus describe only a hardware medium. Further, the statement states that the U.S.P.T.O. will not consider such an amendment to be new matter unless the only embodiment described in the specification is a pure signal. With regard to Claim 11, at least Figure 9 shows that client terminal 2 determines in step SP4 “if a condition relative to a predetermined time period is met.” With regard to Claim 14, at least paragraph 83 of the

¹See the statement dated January 26, 2010 by U.S.P.T.O. Director Kappos.

publication of the specification describes the noted features of this claim. With regard to Claims 15 and 22, it is respectfully submitted that Figure 9 shows that server PS receives and transmits the claimed information. Finally, with respect to Claim 16, examples in the specification of the claimed predetermined time intervals are as noted in the outstanding Office Action. Accordingly, the objection to the specification is believed to be overcome.

With regard to the information disclosure statements filed July 21, 2006 and December 18, 2007, the outstanding office action again failed to provide initialed form 1449s indicating all of the references on these statements as being considered. The information disclosure statement filed July 21, 2006 included a copy of the international search report citing those references, which serves as a statement of relevancy for those references. In particular, MPEP §609.04(a) states “Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.” Further, the information disclosure statements filed December 18, 2007 include a copy of the Japanese Office Action as a statement of relevancy. Accordingly, ***PTO forms 1449s indicating these references as considered are respectfully requested with the next office communication.***

With regard to the rejection of Claims 18 and 20 as unpatentable over Misawa in view of Tsubokura, that rejection is respectfully traversed.

Claims 18 and 20 recite in part:

***storing broadcast contents information including the
broadcasting time and date and the titles of the broadcast
contents that will be broadcasted during a future time period
by one or more broadcasting stations in a storage medium;***

receiving search condition information to specify at least one of the title and the broadcasting station name of a broadcast program as a search condition from an external device;

searching said storage medium for broadcast contents information corresponding to said search condition based on said search condition information received in said receiving;

determining a number of times contents will be broadcasted during a future time period in the broadcast contents information that was obtained as the search result in said searching; and

transmitting information based on said number of times contents will be broadcasted during a future time period for said broadcast contents detected in said determining to said external device.

Misawa describes an on-air information collecting system that appears to only collect broadcast content information for audio data has already been broadcasted. The outstanding Office Action conceded that Misawa does not teach the above highlighted features and cited Tsubokura as describing these features. However, paragraph 15 of Misawa describes that a center 1 collects past broadcasting information from every place, records it to a cassette tape, and uses voice detection software to determine information regarding the ***past*** radio broadcasts. Thus, to modify the device of Misawa to collect data on content to be broadcasted in the future would be a substantial redesign of the device of Misawa. In particular, such a modification would render useless the storage device and voice detection software for determining information regarding the ***past*** radio broadcasts described by Misawa. In this regard, well settled case law holds that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See MPEP §2143.01. In the present case, the proposed combination of references would require a substantial reconstruction and redesign of the elements shown in Misawa, as well require as a change in the basic principle under which the Misawa device was designed to operate, as

noted above. Therefore, the proposed combination of references is not sufficient to render the claims *prima facie* obvious. Consequently, Claims 18 and 20 are patentable over Misawa in view of Tsubokura.

With regard to the rejection of Claims 11-14, 17, 19, and 21 as unpatentable over Misawa in view of Tsubokura and further in view of Nakamura, that rejection is respectfully traversed.

Claim 11 recites in part:

a determining unit configured to determine if a condition relative to a predetermined time period is met; and
a communication unit configured to automatically transmit to a server a request for ***obtaining a number of times contents will be broadcasted during a future time period*** when the condition relative to the predetermined time period is met, and to ***receive the number of times contents will be broadcasted during a future time period*** from said server as a response to the request.

As noted above, to modify the device of Misawa to collect data on content to be broadcasted in the future, as proposed in the outstanding Office Action, would be a substantial redesign of the device of Misawa. Therefore, the proposed combination of references is not sufficient to render the claims *prima facie* obvious. Consequently, Claims 11-14, 17, 19, and 21 are patentable over Misawa in view of Tsubokura and further in view of Nakamura.

With regard to the rejection of Claims 15, 16, and 22 as unpatentable over Ikuo in view of Misawa and further in view of Tsubokura, that rejection is respectfully traversed.

Claim 15 recites in part:

a storage unit configured to store broadcast contents information including the broadcasting time or date, and titles of the broadcast contents;
a communication unit configured to receive from an external device a request for obtaining a number of times contents will be broadcasted during a future time period and a search condition including at least one of a broadcasting period, a title, and a broadcasting station, said communication

unit configured to *transmit to said external device the information representing the number of times contents will be broadcasted during a future time period* as a response to the request; and

a controller configured to *search said storage unit and to generate information representing said number of times contents will be broadcasted during a future time period* based on said search condition.

Ikuo describes a system in which a database stores a program code corresponding to musical pieces already played on the radio. In particular, paragraphs 34 and 35 of Ikuo describe that data is collected based on the program code broadcast with a program. Thus, to modify the device of Ikuo to collect data on content to be broadcasted in the future would be a substantial redesign of the device of Ikuo. In particular, such a modification would render useless the hardware that collects and interprets the program code broadcast with the program described by Ikuo. In this regard, well settled case law holds that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See MPEP §2143.01. In the present case, the proposed combination of references would require a substantial reconstruction and redesign of the elements shown in Ikuo, as well as require a change in the basic principle under which the Ikuo device was designed to operate, as noted above. Therefore, the proposed combination of references is not sufficient to render the claims *prima facie* obvious. Consequently, Claims 15, 16, and 22 are patentable over Ikuo in view of Misawa and further in view of Tsubokura.

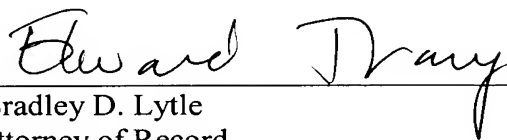
Application No. 10/586,733
Reply to Office Action of February 25, 2010

Accordingly, the pending claims are believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "Bradley D. Lytle", written over a horizontal line.

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Subject Matter Eligibility of Computer Readable Media

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals *per se*, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. *Cf. Animals – Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. *See, e.g., Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

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David J. Kappos

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office